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EXAMINER

CHOI, JACOB Y

ART UNIT	PAPER NUMBER
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2885

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/711,111

Applicant(s)

HEITLAUF, VIVIENNE M.

Examiner

Jacob Y. Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim **15** is objected to because of the following informalities: the phrase "... the fabric can allow light from the light source ... etc." in line 15 is considered unclear. A broad range or limitation followed by linking terms (e.g., preferably, maybe, for instance, especially, can be ... etc) and a narrow range or limitation within the broad range or limitation is considered indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

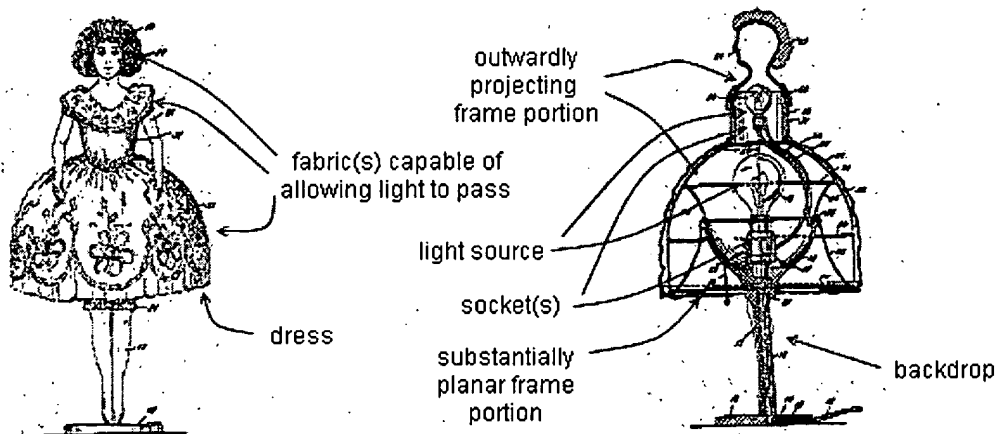
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims **1-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over D. R. Sparks (USPN 1,485,641) in view of Westfall (USPN 6,663,259).

Regarding claim 1, D. R. Sparks discloses a frame (e.g., 22-24) having a *substantially* planar portion (e.g., 24) and an outwardly projecting portion (e.g., 23), the frame being adapted to receive the decorative figurine (e.g., 29, 27, 31, 32, 21), and the outwardly projecting portion (e.g., 23) having a plurality of curved members (e.g., Figure 2) configured to form a dress-shaped lampshade structure (e.g., Figure 1), a stand (e.g.,

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10, 12) coupled to the frame for suspending the frame from a separate structure, a light socket (e.g., 17) positioned between the outwardly projecting portion of the frame (e.g., 23) and the planar portion (e.g., 24) of the frame, configured to operatively receive a light source (e.g., 18, 34) and having means for selectively turning the light source on and off (e.g., 19; paragraph 2, lines 60-80; "... A flexible pull chain 19 extends from the socket through a hole 20 in the bowl and depends therefrom ... etc."), and fabric (e.g., 29, 27, 31, 32, 21) positioned over at least the outwardly projecting portion of the frame, and wherein at least a portion of the fabric is capable of allowing light from the light source to pass through the fabric (e.g., paragraphs 2-3, lines 100-30; ... *while the skirt 32, which is of some sheer translucent material, as silk, extends from the lower edge of the waist ... under portion of the dress in cooperation with the bowl 16 effectually conceals the light bulb and gives a very pleasing external appearance to the lamp ... the head and penetrate the material of which it is composed in a diffused glow ... The lower light is further diffused through the dress, and a soft light is shed downwardly through the under portion 33 ... etc.*").



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D. R. Sparks fails to disclose a hook coupled to the frame for suspending the frame from a separate structure (e.g., as a supporting structure).

Westfall similarly teaches a decorative lighting frame with a rigid support (e.g., 10) in combination with a variety of different decorative elements including decorative fabric (e.g., Figures 2 and 5-11), where a hook (e.g., 36; column 2, lines 20-65; "... to provide such a decorative frame that may be easily mounted to an existing lighting fixture ... etc.") coupled to the frame for suspending the frame from a separate structure.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify decorative lamp frame structure of D. R. Sparks with a hook of Westfall to provide an alternative mounting structure (e.g., other than floor standing) to place and/or hang the lamp frame to other structure (e.g., wall). In other words, the modification would have provided an additional benefit of supporting the frame to other separate structure.

Note: Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Things clearly shown in reference patent drawing qualify as prior art features, even though unexplained by the specification. *In re Mraz*, 173 USPQ 25 (CCPA 1972).

It has been held that the recitation that an element is "*adapted to*" & "*capable of*" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding claim 2, D. R. Sparks in view of Westfall discloses the claimed invention, explained above. In addition, D. R. Sparks discloses the *substantially* planar portion (e.g., 24) of the frame is configured to be positionable contiguous to an adjacent structure (e.g., Figure 2).

Regarding claim 3, D. R. Sparks in view of Westfall discloses the claimed invention, explained above. In addition, D. R. Sparks discloses a backdrop member (e.g., 12) coupled to the frame, the backdrop member having a back surface and the back surface being positionable against a flat surface (e.g., 10) to help stabilize the frame when the frame is suspended by the floor.

Regarding claim 4, D. R. Sparks in view of Westfall discloses the claimed invention, explained above. In addition, D. R. Sparks discloses a material positioned across a bottom portion of the apparatus to soften any glare (e.g., paragraphs 2-3, lines 100-30) emitted from the light source (e.g., 18, 34).

Regarding claim 5, D. R. Sparks in view of Westfall discloses the claimed invention, explained above.

Westfall teaches the frame being made of a rigid material such as metal or plastic ... etc. (e.g., column 4, lines 60-65).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize other rigid material such as plastic instead of wires, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design variation. *In re Leshin*, 125 USPQ 416.

Regarding claim 6, D. R. Sparks in view of Westfall discloses the claimed invention, explained above. In addition, D. R. Sparks discloses the frame is made from wire (e.g., column 2, lines 80-90; "... *curved wires 23 ... circumferential wires 24 ... etc.*").

Regarding claim 7, means for preparing the surface of the frame, whereby the fabric adheres more easily to the frame (e.g., columns 2-3, lines 80-40; "*... it is secured in a suitable manner. This under portion of the dress is cooperation with the bowl 16 effectually conceals the light bulb ... The shade is preferably proportioned to show approximately the amount of figure as represented at 11, as very much more or less of a figure would detract from the general shape ... etc.*").

Regarding claims 8-14, D. R. Sparks in view of Westfall discloses the structural limitations of claimed invention, except for specific method of a use of the particular structure.

It has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to specify detailed method of use of the particular structure of D. R. Sparks in view of Westfall.

Note: The method of forming the device is not germane to the issue of patentability of the device itself. Therefore, limitation(s) has not been given patentable weight.

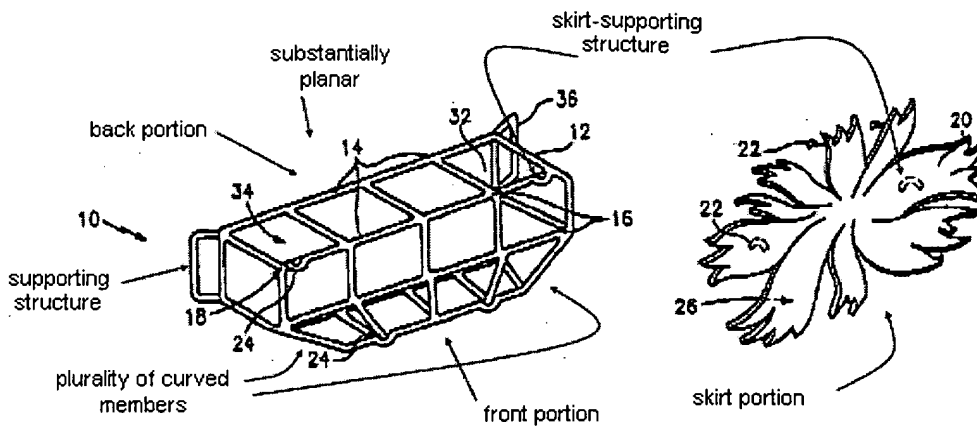
4. Claims **15-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Westfall (USPN 6,663,259) in view of D. R. Sparks (USPN 1,485,641).

Regarding claims 15 & 20, a frame (e.g., 10) comprising a front portion and back portion (e.g., Figure 1), the front portion (e.g., Figure 1) comprising a plurality of curved members (e.g., 14) forming a skirt-supporting structure (e.g., 24, 22; Figure 2), the plurality of curved members having an axial length (e.g., Figure 1), the back portion

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comprising a *substantially* planar portion forming a support structure (e.g., 36) for supporting the frame against a separate adjoining surface when the frame is suspended from the separate adjoining surface (e.g., 36; column 2, lines 20-65; "... *to provide such a decorative frame that may be easily mounted to an existing lighting fixture ... etc.*" & column 4, lines 30-45; "... *to improve the compression fit between the support structure 12 and the lighting fixture 28, clamping member 36 may be disposed at either end, or at the top and bottom, of the support structure 12 ... etc.*"), the *substantially* planar portion having an axial length (e.g., Figure 1), wherein the axial length of the *substantially* planar portion and the axial length of the plurality of curved members are *substantially* juxtaposed (e.g., Figure 1), a light structure (e.g., 28) configured to receive a light source (e.g., 30), the light structure positioned between the *substantially* planar portion and the plurality of curved members (e.g., claim 1; "... *said support structure is formed so as to cover said fixture and to allow sufficient spacing between said light bulbs and said support structure to prevent contact therebetween ... etc.*"), and fabric (e.g., 20) positioned over at least portion of the plurality of curved members (e.g., Figures 1-3), wherein at least portion of the fabric can allow light from the light source to pass therethrough (e.g., column 1, lines 5-20; "... *a decorative element or fabric on the exterior thereof so as to create a varied lighting effect, thereby enhancing the appearance of the lighting fixture ... etc.*") .

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Westfall failed to clearly specify details of the skirt portion being a dress.

However, suggest that (e.g., column 1, lines 5-20; "... a decorative element or fabric on the exterior thereof so as to create a varied lighting effect, thereby enhancing the appearance of the lighting fixture ... etc." & column 2, lines 45-65; "... a frame upon which may be mounted a variety of different decorative elements, including decorative fabrics, metal, glass and plastic, which may be configured in an ornamental pattern, such as a floral or abstract design ... etc.").

D. R. Sparks teaches the details of variety of different decorative elements including an ornamental figure with a dress (e.g., paragraphs 2-3, lines 100-30; ... while the skirt 32, which is of some sheer translucent material, as silk, extends from the lower edge of the waist ... under portion of the dress in cooperation with the bowl 16 effectually conceals the light bulb and gives a very pleasing external appearance to the lamp ... the head and penetrate the material of which it is composed in a diffused glow ... The lower light is further diffused through the dress, and a soft light is shed downwardly through the under portion 33 ... etc.").

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify teachings of Westfall to include variety of differently shaped ornamental figure with a dress (e.g., teachings of D. R. Sparks) to further enhance the appearance of the lighting fixture (e.g., suggested by Westfall).

Regarding claim 16, Westfall in view of D. R. Sparks discloses the claimed invention, explained above. In addition, Westfall discloses a fastener coupled to the frame for suspending the frame from the separate adjoining surface (e.g., 36).

As explained above, the modification between Westfall in view of D. R. Sparks are desirable to further enhance the appearance of the lighting fixture as suggested by the primary reference.

Regarding claim 17, Westfall in view of D. R. Sparks discloses the claimed invention, explained above. In addition, Westfall discloses the fastener comprises a hook (e.g., 36), wherein the *substantially* planar portion abuts the separate adjoining surface, when the frame is suspending fro the hook (e.g., column 2, lines 20-65 & column 4, lines 30-45).

Regarding claim 18, Westfall in view of D. R. Sparks discloses the claimed invention, explained above. In addition, Westfall discloses a backdrop member coupled to the frame, the backdrop member having a back surface and the back surface positionable against a flat surface to help stabilize the frame when the frame is suspended from the separate adjoining surface (e.g., column 2, lines 20-65 & column 4, lines 30-45).

Regarding claim 19, the light structure (e.g., 28) comprises a light socket (e.g., 31) positioned between the plurality of curved members (e.g., Figures 1-3) and the *substantially* planar portion, the light socket (e.g., 31) configured to operatively receive a light source (e.g., 30) and *configured for* selectively turning the light source on and off.

Note: It has been held that the recitation that an element is "*configured for*" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Response to Arguments

5. Applicant's arguments filed December 06, 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Westfall teaches a hook (e.g., 36; column 2, lines 20-65; "... *to provide such a decorative frame that may be easily mounted to an existing lighting fixture ... etc.*" & column 4, lines 30-45; "... *to improve the compression fit between the support structure 12 and the lighting fixture 28, clamping member 36 may be disposed at either end, or at the top and bottom, of the support structure 12 ... etc.*") coupled to the frame for suspending the frame from a separate structure in combination with a similar decorative lighting structure to D. R.

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Sparks. Therefore, the modification is desirable alternatively providing ways to support (e.g., suspend and/or hang) the lamp frame structure of D. R. Sparks to other separate structure(s).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Note: The term "*hook*" is defined as a curved or angular piece of metal or other hard substance for catching, pulling, holding, or suspending something.

Response to Amendment

6. Examiner acknowledges that the applicant has newly added claims 15-20. Currently, claims 1-20 are pending in the application.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y. Choi whose telephone number is (571) 272-2367. The examiner can normally be reached on Monday-Friday (10:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong (James) Suk Lee can be reached on (571) 272-7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jacob Y Choi
Examiner
Art Unit 2885

JC


JONG SUK LEE
SUPERVISORY PATENT EXAMINER